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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,946	07/11/2003	John F. Krumme	003534-105	2163

7590 05/19/2005

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EXAMINER
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HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/616,946

Applicant(s)

KRUMME ET AL.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 10-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/17/05, 12/05/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-9, in the reply filed on 4/11/2005 is acknowledged. The traversal is on the ground(s) that the species provide not burden. This is not found persuasive because applicant has not provided any arguments or evidence showing such to not be a burden; therefore the election is to be treated as being without traverse.

The requirement is still deemed proper and is therefore made FINAL.

Claims 10-18 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/11/2005.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the endwalls of the pieces form the striking face wherein claim 9 recites the frontwalls form the striking face. Claim 9 is not understood being that the present application does not disclose the limitation frontwall. It is not understood as to what applicant intends as the relationship between the insert defined in claim 9 with that defined in claim 1. For the purpose of examination, the frontwalls will be interpreted as

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being the end wall. Furthermore, claim 1 recites the pieces filling the height and width wherein claim 9 recites the pieces filling the height or width. If claim 1 already fills both dimensions, why claim the dimensions being filled in the alternative in the dependent claim. Clarity needed.

### ***Claim Objections***

Claim 9 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The endwalls forming a striking face and the pieces filling the recess are covered by claim 1.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrer (USPN 6431997).

Regarding claim 1, Rohrer discloses a club head having a front face with a recess wherein the recess is filled with face insert and face backing. Rohrer discloses an number of different arrangements in which the faceplate and backing may be combined. A faceplate is noted in Figure 11 as being comprised of multiples striking elements 9 made if the same material having endwalls forming a striking face and at

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least one sidewall in contact with the sidewall of the adjacent piece wherein the pieces fill the height and width of the recess in a closed packed relationship (See Column 4, lines 47 through 53). A faceplate backing **3** is situated behind at least a portion of the striking face and has a non-uniform thickness, material, or both across the extent of the faceplate in the vertical and/or horizontal direction (See Figures 5, 6, 9A, 10A, 12, 13A, and 14). One having ordinary skill in the art would have found it obvious to have any type of faceplate and backing within the recess so long as the club head exhibits improved durability and feel.

Regarding claim 2, Rohrer is silent as to pieces being in contact with the faceplate backing. Though it is silent, one having ordinary skill in the art would have drawn from Rohrer that the pieces would be in contact with the faceplate backing. Rohrer only discloses the faceplate backing being only behind the faceplate insert in just about every embodiment in which would lead to such conclusion to be obvious.

Regarding claim 3, Rohrer discloses the faceplate backing comprising of a single piece of material with the thickness being non-uniform in the horizontal and vertical directions.

Regarding claim 4, Rohrer discloses the faceplate backing having a plurality of layers made of different materials.

Regarding claim 5, Rohrer discloses at least one of the plurality of layers of material being uniform in cross section in the horizontal or vertical direction if the club head is split in two equal halves. Applicant does not define what is intended by the term "uniform"; therefore, it is submitted that the above anticipates the present claim.

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Regarding claim 6, Rohrer discloses the faceplate backing comprising a plurality of discrete backing elements distributed horizontally and/or vertically within the recess (See Figures 12 and 14).

Regarding claim 7, Rohrer discloses in Figure 14 the backing elements composed of at least two different materials (See Column 5, lines 6 through 14).

Regarding claim 8, Rohrer disclose the faceplate backing enclosing one or more voids within the front face recess.

Regarding claim 9, Rohrer disclose the plurality of pieces of the same material having frontwalls forming the striking face

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krumme et al. (USPN 5807190) in view of Rohrer (USPN 6431997).

Regarding claim 1, Krumme et al. discloses a club head having a front face recess and a faceplate insert made of a plurality of discrete pieces having endwalls making the striking and sidewall touching the wall of an adjacent pieces wherein the pieces fill the height and width of the recess. . Krumme et al. does not disclose having a backing. Rohrer discloses a club head having a front face with a recess wherein the recess is filled with face insert and face backing wherein the club head reduces the mishit distance loss (See Background of the Invention). Rohrer discloses a number of different arrangements in which the faceplate and backing may be combined. A faceplate is noted in Figure 11 as being comprised of multiples striking elements 9 made if the same material having endwalls forming a striking face and at least one sidewall in contact with the sidewall of the adjacent piece wherein the pieces fill the

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height and width of the recess in a closed packed relationship (See Column 4, lines 47 through 53). A faceplate backing 3 is situated behind at least a portion of the striking face and has a non-uniform thickness, material, or both across the extent of the faceplate in the vertical and/or horizontal direction (See Figures 5, 6, 9A, 10A, 12, 13A, and 14). One having ordinary skill in the art would have found it obvious to have any type of faceplate and backing within the recess so long as the club head exhibits improved durability, feel, and loss of mishit distance.

Regarding claim 2, Rohrer is silent as to pieces being in contact with the faceplate backing. Though it is silent, one having ordinary skill in the art would have drawn from Rohrer that the pieces would be in contact with the faceplate backing. Rohrer only discloses the faceplate backing being only behind the faceplate insert in just about every embodiment which would lead to such conclusion to be obvious.

Regarding claim 3, Rohrer discloses the faceplate backing comprising of a single piece of material with the thickness being non-uniform in the horizontal and vertical directions.

Regarding claim 4, Rohrer discloses the faceplate backing having a plurality of layers made of different materials.

Rohrer discloses at least one of the plurality of layers of material being uniform in cross section in the horizontal or vertical direction if the club head is split in two equal halves. Applicant does not define what is intended by the term "uniform"; therefore, it is submitted that the above anticipates the present claim.

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Regarding claim 6, Rohrer discloses the faceplate backing comprising a plurality of discrete backing elements distributed horizontally and/or vertically within the recess (See Figure 12).

Regarding claim 7, Rohrer discloses in Figure 14 the backing elements composed of at least two different materials (See Column 5, lines 6 through 14).

Regarding claim 8, Rohrer disclose the faceplate backing enclosing one or more voids within the front face recess.

Regarding claim 9, see above regarding claim 1.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should




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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*AAN*

Alvin A. Hunter, Jr.

  
GREGORY VIDOVICH  
SUPERVISORY PATENT EXAMINER  
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